

member positioned to telescopically receive the first elongated member and further including a means for restricting the expanded portion of the first elongated member from fully passing through both ends of the second elongated member, wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device.

REMARKS

Status of the Claims

The Office Action dated August 22, 2002 has been received and its contents carefully considered. Claims 1-20 are pending. Claims 1-20 have been rejected. Claims 1, 7-9 and 14-16 have been amended. Claims 6, 13, 17 and 18 have been cancelled.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Office Action

The drawings were rejected under 37 C.F.R. § 1.84(p)(5) because they did not include reference signs as indicated in the previous Office Action. FIG. 2 has been amended to include the receptacles 24 and 26. The restriction 18 and outer member 16 are shown in FIG. 3. It is believed that the drawings are now in compliance.

Claims 1-4, 6, 16-17 and 19-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Sorenson (U.S. Patent 5,598,598). Without conceding the propriety of the rejection, independent claim 1 has been amended. The other independent claim 16 has been amended in a generally corresponding fashion. Specifically, the prior art does not teach at least

the features of "the first elongated member further comprising at least one receptacle for receiving a restricting device ...wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device". The prior art directed to Sorenson lacks a teaching of at least one receptacle or member 26 which the Examiner has regarded as a first elongated member. Furthermore, item 54 of Sorenson (which the Examiner regards as a hollow second elongated member) is not configured to be retained by a restricting device located on member 26.

For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 702). Since each and every element, as set forth in the claim, is not found or expressly or inherently described as required by the M.P.E.P., Sorenson can not be said to anticipate the extensible handle as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 5 was rejected under 35 U.S. 103(a) as being unpatentable over Sorenson in view of Messier (U.S. Patent 5,433,12). It is noted that claim 5 depends from amended claim 1 and is therefore patentable over the cited prior art for the same rationale as is claim 1. Messier does not cure the deficiencies of Sorenson because it does not provide a teaching of "at least one receptacle" in the first elongated member or that the first end of the second elongated member is configured to be retained by the restricting device to prevent movement in an axial direction.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re: Wilson*, 424

F.2d 1382, 1385, 165 USPQ 494196 (CCPA 1970). Since the prior art does not teach or suggest all the claimed features withdrawal of the rejection to claim 5 is respectfully requested.

Claims 7-8 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sorenson in view of Monohan et al. (U.S. Patent 6,158,089). Claims 7-8 both depend ultimately from claim 1 and are patentable over the cited prior art for the same rationale as is claim 1. In addition, Monohan et al. does not cure the deficiencies of Sorenson. In fact, Monohan et al. teaches away from the invention as claimed because the end 24 acts to be drawn past the extendible button 40 such that the button 40 can be disposed within any of the apperture services 20. This is in contrast to the present invention which requires that "the first end of the second elongated member is configured to be retained by the restricting device" to prohibit movement in an axial direction. Since the prior art does not teach or suggest all the claimed features, withdrawal of the rejection to claims 7-8 is respectfully requested. It is further noted that claim 18 has been cancelled.

Claims 9-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tallman (U.S. Patent 4,018,421) in view of Sorenson. Without conceding the propriety of the rejections, independent claim 9 has been amended. Specifically, the prior art does not teach or fairly suggest, either singularly or in combination, at least the features of "the first elongated member further comprising at least one receptacle for receiving a restricting device ...wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device". Turning to the prior art, the Examiner admits that "Tallman does not disclose a handle as claimed by the applicant". Sorenson does not cure the deficiencies of Tallman because it does not teach the receptacle in the first elongated end for receiving the restricting device in combination with the feature of the elongated member

configured to be retained by the restricting device to prevent movement in an axial direction.

Since the prior art does not teach or suggest all the claimed features, withdrawal of the rejection to claim 9 is respectfully requested. Claims 10-12 depend from amended claim 9 and are patentable over the cited prior art for the same rationale as is claim 9.

Claims 13-15 were rejected under 35 U.S.C. §103 as being unpatentable over Tallman in view of Sorenson and further in view of Monohan et al.. Dependent claims 13-15 depend from amended claim 9 and are patentable over the cited prior art for the same rationale as is claim 9. The addition of Monohan et al. does not cure the deficiencies of Tallman in view of Sorenson because it does not teach, *inter alia*, that the elongated member is configured to be retained by the restricting device to prohibit movement in an axial direction. In fact, as argued above, Monohan et al. teaches away from the claimed invention because the end 24 moves past the extendible button 40 in operation. Since the prior art does not teach or suggest all the claimed features, withdrawal of the rejection to claims 13-15 is respectfully requested.

In view of the foregoing, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at 202-861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a long horizontal line extending to the right.

Marc W. Butler
Reg. No. 50,219

Attachments:

Request for Approval of Drawing Corrections
Appendix

Date: November 22, 2002

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APPENDIX
VERSION WITH MARKINGS SHOWING CHANGES MADE
IN THE CLAIMS

Claims 6, 13, 17 and 18 have been cancelled.

Claims 1, 7-9, and 14-16 have been amended.

1. (Amended) An extensible jack handle, comprising:

a first elongated member having two ends, the first end positioned to engage a device to be operated, the first elongated member further comprising an expanded portion of increased width and a narrow portion of reduced width relative to the expanded portion;

the first elongated member further comprising at least one receptacle for receiving a restricting device; and

a hollow second elongated member having two ends, the second elongated member positioned to receive the first elongated member, the second elongated member further including a restricting means, wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device.

7. (Amended) The handle of claim [6]1 wherein [at least one of the first locking means] the receptacle comprises [a receptacle sized and positioned to securely receive] a pin.

8. (Amended) The handle of claim 7 wherein the second elongated member further includes at least two receptacle for receiving a restricting device [a second locking means positioned to receive the pin and prevent at least one of extension and retraction of the handle].

9. (Amended) An apparatus for moving an item comprising:
- a base;
 - a supporting means positioned above the base;
 - an arm having two ends, the arm positioned so that one end is pivotally related to the supporting member and the other end is pivotally related to the base;
 - a lifting means; and
 - a handle comprising;
 - a first elongated member having two ends, the first end positioned to be received by the apparatus, the second end having an expanded portion of an increase width;
the first elongated member further comprising at least one receptacle for receiving a restricting device;
 - a second elongated member having two ends, the second elongated member being hollow and positioned to receive the first elongated member, the second elongated member further including a restricting means having a width that is narrower than the width of the expanded portion of the first elongated member wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device.

14. (Amended) The apparatus of claim [13]⁹ wherein [at least one of the first locking means]the receptacle comprises [a receptacle sized and positioned to securely receive] a pin.

15. (Amended) The apparatus of claim 14 wherein the second elongated member further includes [a second locking means positioned to receive the pin and prevent at least one of extension and retraction of the handle]at least one receptacle for receiving a restricting device.

16. (Amended) An extensible handle, comprising:
a first elongated member having two ends, an expanded portion of increased width, and a narrow portion of reduced width relative to the expanded portion;
the first elongated member further comprising at least one receptacle for receiving a restricting device;

a hollow second elongated member having two ends, the second elongated member positioned to telescopically receive the first elongated member and further including a means for restricting the expanded portion of the first elongated member from fully passing through both ends of the second elongated member wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained by the restricting device.

Approved
JKS
2/6/03

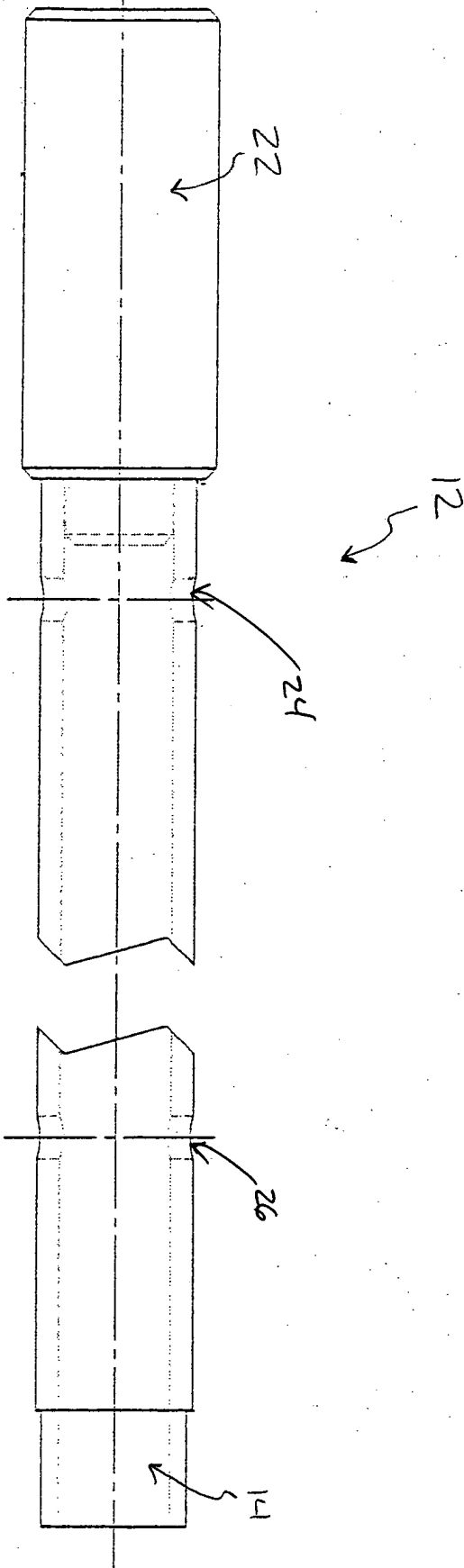


FIG. 2